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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,731	02/10/2000	RAINER HAHN	(0)-6676.2	6338

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M ROBERT KESTENBAUM
11011 BERMUDA DUNES NE
ALBUQUERQUE, NM 87111

EXAMINER

WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/402,731

Applicant(s)

HAHN, RAINER

Examiner

Eric F Winakur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) 34-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. Claims 1 - 33 and 89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 1, the phrase "of hard tissue, in particular carious dental tissue" renders the scope of the claim unclear, as it is unclear whether Applicant intends the claim to be limited to the larger scope of 'hard tissue' or the narrower scope of 'carious dental tissue'. With regard to claim 2, use of the phrase "preferably" renders the scope of the claimed subject matter unclear. With regard to claim 4, the final phrase of the claim, "to which ... is assigned" is unclear; the language does not make clear the relationship between the elements. With regard to claims 7 and 8, use of the term 'preferably' renders the scope of the claimed subject matter unclear, as the claims set forth limitations of both broader and narrower scope. With regard to claim 7, the phrase "its long axis" implies that a 'long axis' has previously been defined in relation to the grip part; however, no such axis is recited. With regard to claim 10, the phrase "the stimulus" lacks antecedent basis. With regard to claim 11, the phrase "the grip part" lacks antecedent basis. With regard to claim 13, the phrases "the acting sensor part" and "the recording sensor part" lack antecedent basis. With regard to claim 14, the claim is not further limiting, as it merely repeats features found in the base claim. With regard to claim 19, the phrases "the free front surface" and "the probe

position indicator" lack antecedent basis. With regard to claim 20, the phrase "the end" lacks antecedent basis. With regard to claim 21, the phrase "the free end" lacks antecedent basis; it is unclear what Applicant intends to define by the phrase "can be pushed ... with widening". With regard to claim 89, the claim does not appear to include a transition phrase; thus, it is unclear what Applicant considers the preamble of the claim and what is considered to be the body of the claim.

3. Although Applicant states that the claims have been amended to overcome the previously recited 112, second paragraph rejections no amendments were provided for claims 1 - 4. Further, Applicant contends that since dependent claims recite the optional features the objections are overcome. This is not persuasive, as the scope of the claims is still unclear. The claim language itself must clearly define the invention. Use of the phrases "in particular" and "preferably" fails to clearly define the scope of the claimed subject matter.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim improperly defines the pressure gauge in relationship to a part of the human body (tissue). Applicant should recite that the gauge is "adapted to be limited by the tissue" to avoid this problem.

Claim Rejections - 35 USC § 102

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6. The rejection of claims 1 - 5 under 35 U.S.C. 102(e) as being anticipated by Omata is hereby maintained. Applicant's arguments have been considered but are not deemed persuasive. Applicant contends that Omata does not disclose every feature of the claimed invention in that Omata does not teach an apparatus for determination of remineralization ability of hard tissue. It is noted that while the preamble of claim 1 refers to this intended use, the claimed elements merely require a measurement device for local measurement of at least one of a number of possible properties. As Omata teaches a device capable of measuring hardness (one of the listed properties), the reference is considered to meet the claim. Applicant's discussion of the measurement of porosity and Omata's embodiment for measurement of soft tissue are noted. Porosity is only one of several properties set forth in claim 1; as mentioned above, Omata teaches measurement of hardness, which is another of the properties set forth in the claim. The discussion of an alternate embodiment of Omata, not relied upon by Examiner and not related to the claimed subject matter, is not relevant to the rejection of claims 1 - 5. As Omata teaches all of the claimed features, the rejection is proper, and is hereby maintained.

Allowable Subject Matter

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or suggest an apparatus for determining remineralization ability of hard tissue that includes a measuring head having a probe section that is introducible into a working channel of the hard tissue wherein the probe is

able to measure the porosity of the hard tissue based on a measurement of fluid leakage from the tissue to be investigated.

8. Claims 6 - 33 and 89 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 703/308-3130. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0858.



Eric F Winakur
Primary Examiner
Art Unit 3736

31 October 2003